

## **REMARKS**

Applicant has carefully reviewed the Final Office Action mailed September 9, 2007 and offers the following remarks.

### **Status of the Claims**

Claims 1-7, 9, 12-15, and 20-27 are pending. No claims are added or cancelled. Accordingly, claims 1-7, 9, 12-15, and 20-27 remain pending.

### **Rejection Under 35 U.S.C. § 102(b) – Porter**

Claims 1, 9, 13-15, and 23-26 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Application Publication No. 2002/0178771 A1 to Porter (hereinafter “Porter”). Applicant respectfully traverses. For the Patent Office to prove anticipation, each and every element of the claims must be present in the reference. Furthermore, the elements of the reference must be arranged as claimed. MPEP § 2131.

Prior to addressing the merits of the rejection, Applicant offers the following brief summary of the present invention. The present invention is directed to a lock comprising a lock mechanism adapted to receive and lock a keep. The keep is a structure into which a mechanism engages to secure or lock an enclosure, cabinet, etc. (See, e.g., Specification, p. 5, ll. 2-4) The lock mechanism includes a bolt adapted to engage with the keep in a locking position, and a latching mechanism. The latching mechanism includes a deadlock adapted to engage the bolt in the locking position, and electronic circuitry adapted to operate the latching mechanism.

The lock also comprises an outer cover which extends over both the locking mechanism and the keep when the keep is locked. The outer cover completely shields and prevents access to the locking mechanism and the keep. By extending the outer cover over both the lock mechanism and the keep, the lock can more easily resist physical attacks such as drilling, cutting, and grinding by unauthorized persons to gain access to the enclosure or other structure the lock is securing. Also, the outer cover protects the lock mechanism and the keep from the effects of weather.

### **Effect of “Adapted to” Claim Language**

Initially, Applicant addresses the Patent Office’s statement regarding the effect of the claim language “adapted to.” Citing to *In re Hutchinson*, 69 U.S.P.Q. 138 (1946), the Patent

Office summarily concludes that the element ““adapted to’...does not constitute a limitation in any patentable sense.” (Final Office Action mailed September 6, 2007, p. 3). The Patent Office is incorrect and its reliance on *In re Hutchinson* is misplaced. Unlike the present application, *In re Hutchinson*’s “adapted to” claim language was optional and not intended to be a functional or structural limitation.

MPEP 2111.04 addresses “adapted to” language as a claim limitation when defining structure. There, it states that such language is to be interpreted as a limitation if it recites structure that is not intended to be optional by its language in wording. Such is the case for the claims of the present application. For example, in the language of claim 1, the “locking mechanism [is] adapted to receive and lock to an associated keep.”

Further, the MPEP and subsequent case law have firmly established that “adapted to” claim language can also be a limitation if it defines functional limitations. In pertinent part, MPEP § 2173.05(g) requires that “[a] functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used.” (emphasis added). Moreover, relevant case law affirms and supports this requirement, particularly with respect to the language “adapted to.” As cited in MPEP § 2173.05(g), “[i]n a claim that was directed to a kit of component parts capable of being assembled, the Court held that limitations such as "members adapted to be positioned" and "portions . . . being resiliently dilatable whereby said housing may be slidably positioned" serve to precisely define present structural attributes of interrelated component parts of the claimed assembly. *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976) (emphasis added).

The decision *In re Hutchinson* was not based on its language defining additional structure or functions and is thus not applicable here. The Applicant respectfully requests that the Patent Office withdraw its statement concerning the language “adapted to” and affirm the dictates of MPEP §§ 2111.04, 2173.05(g), and the relevant case law with respect to evaluating and considering structural and functional limitations in claims.

Patent Office’s Rejection of Claims 1, 9, 13-15, and 23-26 As Being Anticipated by Porter

The Patent Office contends that the mounting plate 84 of Porter is the same as the outer cover of the present invention. (Final Office Action mailed September 6, 2007, p. 2). The Patent

Office is incorrect. The mounting plate 84 of Porter is exactly what its name denotes: a mounting plate. The mounting plate 84 provides a flat surface for mounting the latch assembly 14 on top of. (Porter, ¶ 0040). Since the mounting plate 84 is a flat surface that supports the latch assembly 14, it cannot and does not cover the latch assembly 14. This is particularly shown in the side view of Figure 4, where the mounting plate 84 is clearly located beneath the latch assembly 14 and does not cover it. If the mounting plate 84 were to extend to the securing bracket 30, the door 10 would not open. Therefore, it is physically impossible for the mounting plate 84 to extend over the securing bracket 30. Thus, it is physically impossible for the security system of Porter to include an outer cover that extends over the lock mechanism and the keep. Therefore, Porter does not and cannot teach, suggest, or disclose “an outer cover which extends over both the lock mechanism and the keep when the keep is locked to the lock and which prevents access to both the lock mechanism and the keep.” Accordingly, the Patent Office has failed to show where each and every element of claim 1 is present in Porter. As such, Porter cannot and does not anticipate claim 1. For the above reason, Applicant respectfully requests that the rejection of claim 1 under 35 U.S.C. § 102(b) be withdrawn..

Porter does include an outer cover that covers the latch assembly 14. The outer cover is element 36 in Porter, as shown in Figure 2A. However, this cover 36 does not cover the keep 30 (called “securing bracket” in Porter) as required by the claimed invention. This is clearly shown in Figure 2B of Porter. There, note that the locking mechanism bolt 20 extends outwardly beyond the edge of the cover 36 as well as the mounting plate 84. It extends into a keep 30 that is clearly located outside of the boundaries of the cover 36 and the mounting plate 84, as illustrated in Figure 1.

Claims 9, 13-15, and 23-26 depend, either directly or indirectly, from claim 1 and the rejection of claims 9, 13-15, and 23-26 should be withdrawn for at least the same reasons as claim 1. Applicant respectfully submits that claims 1, 9, 13-15, and 23-26 are in condition for allowance and notice of the same is requested at the earliest possible date.

#### **Rejection Under 35 U.S.C. § 103(a) – Porter and Gartner**

Claims 2-7 and 22 were rejected under 35 U.S.C. §103(a) as being unpatentable over Porter in view of U.S. Patent No. 4,509,350 to Gartner (hereinafter “Gartner”). Applicant respectfully traverses. For the Patent Office to establish *prima facie* obviousness, the Patent

Office must show where each and every claim element can be found in the combination of references.

Claims 2-7 and 22 depend, either directly or indirectly, from claim 1. Accordingly, the rejection of claims 2-7 and 22 should be withdrawn for at least the same reasons as claim 1. Thus, it is not necessary to address any other points regarding the Patent Office's rejection. However, Applicant will note that the Patent Office refers to the plate-like body 31 in Gartner as an "external cover." Nowhere in Gartner is the term "external cover" found. On the contrary, Gartner describes and uses the plate-like body 31 in a similar manner as Porter describes and uses the mounting plate 84. The plate-like body 31 of Gartner is mounted on the inside wall of a safe door 11. A lock housing 13 containing lock works 12 is mounted to the plate-like body 31 as part of a protective lock mounting plate 30. (Gartner, col. 2, ll. 21-62). While the plate-like body 31 may protect the lock works 12, the plate-like body 31 does not cover the keep, which in Gartner is the safe wall opening 16. Therefore, as with Porter, Gartner does not and cannot teach, suggest, or disclose "an outer cover which extends over both the lock mechanism and the keep when the keep is locked to the lock and which prevents access to both the lock mechanism and the keep." Additionally, Applicant reserves the right to provide additional arguments against the rejection of claims 2-7 and 22 in the future. Applicant respectfully submits that claims 2-7 and 22 are in condition for allowance and notice of the same is requested at the earliest possible date.

#### **Rejection Under 35 U.S.C. § 103(a) – Porter and Buccola**

Claims 12, 20, and 21 were rejected under 35 U.S.C. §103(a) as being unpatentable over Porter in view of U.S. Patent No. 6,486,793 B1 to Buccola (hereinafter "Buccola"). Applicant respectfully traverses. The standards for obviousness are set forth above.

Claims 12, 20, and 21 depend from claim 1. Accordingly, the rejection of claims 12, 20, and 21 should be withdrawn for at least the same reasons as claim 1. Thus, it is not necessary to address any other points regarding the Patent Office's rejection. Applicant respectfully submits that claims 12, 20, and 21 are in condition for allowance and notice of the same is requested at the earliest possible date.

**Rejection Under 35 U.S.C. § 103(a) – Porter and Maple**

Claim 27 was rejected under 35 U.S.C. §103(a) as being unpatentable over Porter in view of U.S. Patent Application Publication No. 2004/0108734 A1 to Maple et al. (hereinafter “Maple”). Applicant respectfully traverses. The standards for obviousness are set forth above.

Claim 27 depends indirectly upon claim 1. Accordingly, the rejection of claim 27 should be withdrawn for at least the same reasons as claim 1. Thus, it is not necessary to address any other points regarding the Patent Office’s rejection. Applicant respectfully submits that claim 27 is in condition for allowance and notice of the same is requested at the earliest possible date.

**Conclusion**

Applicant requests reconsideration of the rejections in light of the amendments and remarks presented herein. Applicant earnestly solicits claim allowance at the Examiner’s earliest convenience.

Respectfully submitted,

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Date: January 3, 2008

Attorney Docket: 1031-003